



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,943	11/13/2003	Chi-Jung Chang	0941-0866P	6577

2292 7590 06/22/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,943

Applicant(s)

CHANG ET AL.

Examiner

Sanza L. McClendon

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 5-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 1711

DETAILED ACTION
Response to Amendment

1. In response to the Amendment received on April 6, 2006, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 2-4. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claims 1-13 has been overcome by the amendment and has hereby been withdrawn for consideration.

Response to Arguments

2. Applicant's arguments, see Remarks/Amendment, filed April 6, 2006, with respect to claims 1-13 have been fully considered and are persuasive. The rejection of claims 1-13 under both 35 USC 102(b) and 35 USC 102(e) or, in the alternative, under 35 USC 103(a) by Noguchi et al has been withdrawn. It appears applicant is relying on the amendment better defining said claimed reactive surfactant as comprising "polyoxyethylene polyaryl phenyl ether or nonylphenyl amine salt" to distinguish over the prior art. After reconsideration, it is deemed that Noguchi et al does not expressly teach and/or render obvious the use a reactive surfactant comprising the moieties as instantly claimed. Therefore the rejection of Noguchi et al has been withdrawn. Concerning the amendment to the claims; the examiner appreciates applicant's appendix documents II and I, however these were not convincing since these are not in English (non-translated). The examiner is unable to discern if Appendix I is describing MS-60 and its constituents, although it can be seen that MS-60 is listed on page 2/5. However, it appears that on page 5/5 of Appendix I is describing SINOPOL 609 as comprising polyoxyethylene polyaryl phenyl ether and not MS-60. Additionally, while REM-A10 is listed on page 1 of Appendix II, it is unclear if said product comprises a nonylphenyl amine salt. Clarification is requested. With regards to applicant's amendment, it has warranted a new rejection—see below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it

Art Unit: 1711

is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 5-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for bis (polyoxyethylene polyphenyl ether) methacryl sulfate ammonium salt and REM-A101—see examples, does not reasonably provide enablement for all reactive surfactants that comprise polyoxyethylene polyaryl phenyl ethers or nonylphenyl amine salts. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use or make the invention commensurate in scope with these claims. Applicant only teaches MS-60 and REM-A101. It is unclear if applicant is intending to claim every reactive surfactant comprising said moieties or not. Applicant's disclosure only proved for use of those found in the examples, wherein it can be seen in example 1 MS-60 comprising the claimed constituent. As for the others found in applicant's disclosure, it is unclear if these actually comprise nonylphenyl amine salts or not—see above remarks. Appropriate action is requested.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sanza McClendon
Examiner

Art Unit 1711

SMc